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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/432,869	11/02/1999	STEVEN W. BROWN	ZAY-99-065	1715

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EXAMINER

RAY, GOPAL C

ART UNIT	PAPER NUMBER
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2181

DATE MAILED: 06/12/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/432,869

Applicant(s)
Steven W. Brown

Examiner
Gopal C. Ray

Art Unit
2181

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Nov 2, 1999
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirements.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other: _____

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1. Claims 1-11 are presented for examination.
2. The drawings filed on 11/2/1999 are objected to by the USPTO draftsman. See PTO-948 for objections to the drawings. The drawings are acceptable for examination purposes only. Formal drawings will be required when the application is allowed. Direct any inquiries concerning drawing review by the PTO draftsman to the Drawing Review Branch at (703) 305-8404.
3. The abstract of the disclosure is objected to because the word "sing" (line 2) should be --single--. Correction is required. See MPEP § 608.01(b).
4. Applicant should provide serial no. of co-pending US Patent application disclosed on page 13, lines 17-20. Furthermore, on page 5, lines 13-16, "ROM 6 (two occurrences) and transaction layer software 5" should be changed to --ROM 7 and transaction layer software 6-- respectively. Moreover, the specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.
5. Claim 2 is objected to because of the following informalities: "a entry" (lines 1-2) should be changed to --an entry--. Furthermore, all claims should be revised carefully to eliminate all grammatical errors and antecedent basis problems.

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6. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1-11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over applicant's admitted prior art in view of US Patent 5,809,331 issued to Staats et al.

As per claim 1, applicant's admitted prior art teaches "creating a configuration ROM image for each link device; and presenting said configuration ROM image for each said link device" in Fig. 2, element 7 and page 4, lines 9-20.

Applicant's admitted prior art fails to teach "an individual configuration ROM image for each link device". However, the above feature was well known to one of ordinary skill in the art at the time the invention was made as evidenced by Staats et al. The reference of Staats et al. teaches the feature in Fig. 2, element 50 and col. 4, lines 53-61. One of ordinary skill in the art at the time the invention was made would have realized that it is important to have an individual configuration ROM image for each link device for reliable operation of the computer system because that will match the proper driver to the proper device

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efficiently. The reference of Staats teaches that in col. 1, lines 37-54. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the applicant's admitted prior art to implement the above feature of Staats because that would make the applicant's admitted prior art system's operation more reliable.

Furthermore, it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

As per claim 2, applicant's admitted prior art teaches "said configuration ROM image includes an entry for a distinct identifier for a corresponding link device" in Fig. 2, elements 5a, 5b and page 4, lines 9-20.

As per claim 3, applicant's admitted prior art teaches the added feature in Fig. 2, element 7 and page 4, lines 9-20.

As per claim 4, applicant's admitted prior art teaches "Wherein said creating and presenting said configuration ROM image is carried out by transaction layer software" in Fig. 2, element 6 and page 5, lines 13-16.

As per claims 5 and 6, the claims recite apparatuses which parallel method claims 1 and 2 respectively. In teaching the construction and use of the device, the combination of applicant's admitted prior art and US Patent 5,809,331 issued to Staats et al. teaches corresponding apparatuses.

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As per claims 7 and 8, the claims are rejected for similar reasons as discussed in the rejection of claims 5 and 6 respectively.

As per claims 9-11, the claims are rejected for similar reasons as discussed in the rejection of claims 1-3 respectively with the exception of "a program storage device readable by a machine, tangibly embodying a program of instruction executable by the machine to perform the method". However, applicant's admitted prior art teaches the feature on page 4, lines 16-17.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is urged to consider the references. However, the references should be evaluated by what they suggest to one versed in the art, rather than by their specific disclosure. Furthermore, applicant is reminded of the duty to disclose as set forth in 37 CFR § 1.56.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gopal C. Ray whose telephone number is (703) 305-9647. The examiner can normally be reached on Monday - Friday from 8:00 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Wong, can be reached on (703) 305-3477. The fax phone numbers for this Group

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are (703) 746-7238 for "After-final", (703) 746-7239 "official" and (703) 746-7240 for "Non-official/Draft".

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [peter.wong@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to TC2100 receptionist whose telephone number is (703) 305-3900.

Gopal C. Ray

**GOPAL C. RAY
PRIMARY EXAMINER
GROUP 2360**